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PATENT APPLICATION

DAE
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

EDDIE F. RAY, III ET AL.

Appln. No.: 10/766,504

Filed: January 27, 2004

For: BONE GRAFTS

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Examiner: Julianna Nancy Harvey

Art Unit: 3733

Confirmation No.: 3501

March 16, 2009

The Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION, UNDER 37 C.F.R. § 1.103(a), FOR
SUSPENSION OF PROCEEDINGS FOR SIX (6) MONTHS

Sir:

Applicants hereby petition, under 37 C.F.R. § 1.103(a), for suspension of proceedings in the above-identified patent application. The fee of \$200, required under 37 C.F.R. § 1.17(g), may be charged to our Deposit Account No. 06-1205.

A first Petition under 37 C.F.R. § 1.103(a) was filed in the subject application on December 1, 2008. That petition was denied by action dated January 16, 2009. The present petition is now made because circumstances have significantly changed since the filing of that first Petition, as explained more fully below.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

March 16, 2009
(Date of Deposit)

Ronald A. Clayton
(Name of Attorney for Applicant)

Signature

March 16, 2009
Date of Signature

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I. STATEMENT OF FACTS

A. The Subject Application

The subject application is directed generally to bone grafts, which in preferred embodiments may be used to fuse adjacent vertebrae in the spine to provide stabilization of the spinal column. All claims in the subject application, numbers 1 to 66, were presented for the purpose of provoking an interference with U.S. Patent No. 6,511,509 (Ford, et al.). More particularly, these claims were copied either identically or in modified form from Claims 1 to 10, 13, 16, 17, 20, and 22 to 25 of the Ford Patent.

B. The Restriction Requirement

A restriction requirement was made in an Official Action dated December 13, 2007; was made final in an Official Action dated May 30, 2008; and further prosecution has now been limited to Claims 1 to 4, 6, 7, 12, 13, 15, 20, 23, 26, 28, 31 to 35, 37, 38, 43, 44, 51, 54, 57, 65 and 66. A Petition, Under 37 C.F.R. § 1.144, for Review of Final Requirement of Restriction was subsequently dismissed and Applicants are not requesting reconsideration of that decision.

C. The Official Actions Dated May 30, 2008 and January 21, 2009

All pending claims were initially, and then finally, rejected in view of a number of citations by Actions dated May 30, 2008 and January 21, 2009. Concurrently with responding to the Action of May 30, Applicants requested reexamination of the claims issued in the Ford Patent, again which were identical or substantially identical to those rejected in the subject case. Applicants' request was based on the same citations as applied against those claims herein.

D. The Reexamination of the Ford Patent

On January 6, 2009, Applicants' request for reexamination of the Ford Patent was granted under Reexamination Control No. 90/009,348. The Patent and Trademark Office found that a substantial new question of patentability existed with respect to all Ford claims in issue on the basis of the same citations applied against those claims in this case. Moreover, the PTO cited three additional patents, not cited by the Applicants in their request, that also raised a substantial new question of patentability. The owner of the Ford Patent did not file a Patent Owner's Statement within the time permitted.

II. ARGUMENT

To reiterate, all claims in the subject case were presented for the purpose of provoking an interference with the Ford Patent and were copied either identically or in modified form from Claims 1 to 10, 13, 16, 17, 20, and 22 to 25 of that patent. Because Applicants filed its initial petition to suspend proceedings concurrently with their request for reexamination of the Ford Patent, obviously no action had been taken on the merits of the request at that time. Accordingly, that petition was denied, the PTO stating:

The Office must balance the burden of timely examinations and needs of the public to know which claims it faces with the needs of applicants in pursuing claims which reflect the scope to which they are entitled. The petition fails to establish why suspension of action in the case is necessitated by a reexamination request in another patent. Accordingly, applicant has failed to establish good and sufficient reasons to delay the prosecution.

(Decision on Petition, January 16, 2009)
(Emphasis added)

However, circumstances have now significantly changed in that the request for reexamination of the Ford Patent has been granted. A substantial new question of patentability of those very claims has now been found by the PTO.

It is respectfully submitted that a consistent ultimate determination of patentability of those claims is of particular interest to Ford, the Applicants and the PTO. If the claims are finally determined to be patentable to Ford, then they should similarly be determined to be allowable to Applicants. Similarly, if they are unpatentable on bases applicable to both parties, such determination should be made uniformly.¹

Reexaminations are required to be conducted "with special dispatch", 37 C.F.R. § 1.550(c). Therefore, it is to be expected that reexamination of the Ford Patent will proceed expeditiously.

Therefore, Applicants respectfully petition to suspend action on the subject case for six (6) months to permit further action by the PTO on the reexamination of the Ford Patent and for the PTO to make a consistent determination of patentability of the same or substantially the same claims to both parties.

^{1/} It is submitted that at least U.S. Patent No. 6,371,988 (Pafford, et al.) is not a reference against the subject application as it is, in fact, a parent of the subject application.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,


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